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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,702	12/20/2004	Thomas Salutzki	5255-43PUS	1014

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COHEN, PONTANI, LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

EXAMINER

WILLIAMS, THOMAS J

ART UNIT	PAPER NUMBER
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3683

MAIL DATE	DELIVERY MODE
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01/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,702

Applicant(s)

SALUTZKI, THOMAS

Examiner

Thomas J. Williams

Art Unit

3683

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Acknowledgement is made in the receipt of the amendment filed November 19, 2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 9, 10 and 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,618,899 to Ginzl et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

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Re-claim 9, Ginzel et al. disclose an apparatus for opening and closing a door leaf, comprising: a housing made of a polyoxymethylene plastic (see column 7 lines 18-37), the housing has a recess; a piston 6 made of polyoxymethylene (see column 2 lines 62-66 and column 7 lines 18-37), the piston has a toothed rack 11; a closing shaft 3 comprises a pinion 12 that engages the rack 11 (see figure 4); a closing spring 13 is arranged in the recess and acts on the piston, Ginzel et al. incorporate by reference in its entirety US 4,019,220 which discloses a piston and rack apparatus, wherein the rack is made of metal and the piston is molded around the rack. The step of embedding the metal rack in the piston by molding the polyoxymethylene plastic around the rack to form a one piece element is considered a process step, and as such the claim becomes a product by process. However, the process step can not be relied upon for determining patentability in an apparatus claim, see MPEP 2113.

Re-claim 10, the piston and housing are formed by injection molding, see column 3 lines 33-37.

Re-claims 12 and 13, the housing is fitted with bearing shells 16, the bearings are made of polyoxymethylene plastic; the bearing shells are press fitted into the housing and welded using ultrasonic welding, see column 9 lines 11-18.

Re-claims 14-16, end plugs 18 and 19 are made of polyoxymethylene plastic and attached by ultrasonic welding; the openings at each end are broadly interpreted as hydraulic openings which are subsequently sealed with caps 18 and 19.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9, 10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/36255 to Ginzel et al. in view of US 6,077,908 to Yahiro.

Re-claims 9, 10 and 12-16, Ginzel et al. teach an apparatus for opening and closing a door leaf, comprising: a housing made of plastic, the housing has a recess; a piston 6 made of plastic, the piston has a toothed rack 11; a closing shaft 3 comprises a pinion 12 that engages the rack 11 (see figure 4); a closing spring 13 is arranged in the recess and acts on the piston; the piston and housing are formed by injection molding (see abstract); Ginzel et al. incorporates by reference in its entirety US 4,019,220 which discloses a piston and rack apparatus, wherein the rack is made of metal and the piston is molded around the rack; the housing is fitted with bearing shells 16, the bearings are made of plastic; the bearing shells are press fitted into the housing and attached by ultrasonic welding (a machine translation confirms this); end plugs 18 and 19 are made of plastic and are attached by ultrasonic welding; the openings at each end are broadly interpreted as hydraulic openings which are subsequently sealed with caps 18 and 19. The step of embedding the metal rack in the piston by molding the polyoxymethylene plastic around the rack to form a one piece element is considered a process step, and as such the claim becomes a product by process. However, the process step can not be relied upon for determining patentability in an apparatus claim, see MPEP 2113

Ginzel et al. teach the type of plastic used is preferably glass fiber or carbon fiber reinforced, but fail to teach the specific type of plastic used as being a polyoxymethylene plastic.

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Yahiro teaches a glass fiber reinforced polyoxymethylene plastic used for making a variety of products, such as brake pistons, caps, housings and other various structures, see column 8 lines 57-67 to column 9 lines 1-51. The polyoxymethylene plastic provides excellent heat stability and weatherability, and as such is useful for outdoor conditions, as would be experienced by a door closing mechanism. It would have been obvious to one of ordinary skill in the art to have manufactured the various parts of Ginzel et al. from a polyoxymethylene plastic as taught by Yahiro, thus providing a durable product resistant to heat and inclement weather.

Response to Arguments

6. Applicant's arguments filed November 19, 2007 have been fully considered but they are not persuasive. Ginzel et al. (US '899) specifically disclose a variety of engineered plastics that may be used in the construction of the door closer components, see column 7 lines 18-36. The examiner considers the piston to be one of the major door components. As such the rejection appears proper. As noted above the precise process steps of producing the piston/rack assembly is interpreted as a product by process, and as such is not considered by the examiner when determining patentability. It is noted that Ginzel et al. (WO '255) provide motivation for using a plastic when constructing the piston. Yahiro is merely relied upon as a reference that teaches the common use of a polyoxymethylene plastic and the benefits associated with said plastic. It would appear that this type of plastic would last substantially longer and have a greater resistance to decay.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is 571-272-7128. The examiner can normally be reached on Wednesday-Friday from 6:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi, can be reached at 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-6584.

THOMAS J. WILLIAMS
PRIMARY EXAMINER

TJW

January 15, 2008

Thomas Williams
AV 3683
1-16-08